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10/565,368	06/21/2006	David Neil Slatter	200308882-3	2182

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EXAMINER

SAVUSDIPHOL, PAULTEP

ART UNIT	PAPER NUMBER
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2876

NOTIFICATION DATE	DELIVERY MODE
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08/28/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/565,368

Applicant(s)

SLATTER, DAVID NEIL

Examiner

PAULTEP SAVUSDIPHOL

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/2008 has been entered.

Receipt is acknowledged of the amendment, filed on 7/29/2008, which has been entered in the file. Claim 9 has been cancelled. Claims 1, 3-8 and 10-20 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shih et al. (US 6,674,923 B1)** in view of **Spurr et al. (US 6,381,418 B1)**.

Regarding **claim 1**, **Shih** discloses an index print, comprising:

a substrate (Col. 3, lines 20-27 & Fig. 1); and

a plurality of index images **16** printed with low resolution on the substrate (Col. 3, lines 20-34 & Fig. 1); and

wherein at least one of the plurality of index images is associated with a memory tag (Col. 5, line 58 - Col. 6, line 5 & Col. 8, lines 45-57),

wherein one of the plurality of memory tags is configured to store at least one of a list of index images, respective locations of the index images, and locations of the memory tags associated with at least one of the plurality of index images (Col. 8, lines 45-57).

Regarding **claim 3**, **Shih** discloses an index print according to claim 1, wherein the memory tag associated with at least one of the plurality of index images is further configured to store data related to the initial creation of the high resolution image or the index image (Col. 3, lines 42-62 & Col. 5, lines 62-64).

Regarding **claim 4**, **Shih** discloses an index print according to claim 1, wherein the memory tag associated with at least one of the plurality of index images is further configured to store data relating to the content of the high resolution image or the index image (Col. 3, lines 42-62 & Col. 5, lines 62-64).

Regarding **claim 5**, **Shih** discloses an index print according to claim 1, wherein the memory tag associated with at least one of the plurality of index images is located on the substrate adjacent to the respective index image (Col. 5, lines 62-64 & Fig. 13).

Regarding **claim 6**, **Shih** discloses an index print according to claim 1, wherein the substrate is divided into a plurality of index image areas **16** (Fig. 1), each of which has printed thereon a single index image and is provided with an associated memory tag (Col. 3, lines 20-34 & Col. 5, lines 62-64 – *wherein it is disclosed that an index print has "an associated memory tag" thereon*).

Regarding **claim 7**, **Shih** discloses an index print according to claim 6, wherein each memory tag associated with at least one of the plurality of index images is located in the same place in the respective index image area (Col. 5, lines 62-64 & Fig. 13 – *wherein it is disclosed one memory tag associated with "at least one...index image" shown in an area of the print*).

Regarding **claim 8**, **Shih** discloses an index print according to claim 6, wherein each memory tag associated with at least one of the plurality of index images is located in the same place with respect to the respective index image (Col. 5, lines 62-64 & Fig. 13 – *shown in the same location respective to the index image*).

Regarding **claim 10**, **Shih** discloses an index print according to claim 1, wherein the index print includes an icon at the location for each memory tag (Fig. 13).

Regarding **claim 11**, **Shih** discloses an index print according to claim 1, wherein each of the plurality of memory tags is adapted to be inductively powered to transmit data stored thereon (Col. 5, line 58 – Col 6, line 5).

Regarding **claim 12**, **Shih** discloses a print medium, comprising:

a substrate with a printable surface (Col. 3, lines 20-27 & Fig. 1); and

wherein the printable surface comprises a plurality of index images that are printed with low resolution (Col. 3, lines 20-34 & Fig. 1) and a memory tag is associated with at least one of the index images (Col. 5, line 58 - Col. 6, line 5 & Col. 8, lines 45-57);

wherein one of the plurality of memory tags is configured to store at least one of a list of index images, respective locations of the index images, and locations of

memory tags associated with at least one of the plurality of index images (Col. 8, lines 45-57).

Regarding **claim 13**, **Shih** discloses a print medium as claimed in claim 12, wherein each memory tag is adapted to be inductively powered for receiving data to be written to it (Col. 5, line 58 – Col 6, line 5).

Regarding **claim 14**, **Shih** discloses a print medium according to claim 12, wherein the substrate is divided into a plurality of index image areas (Col. 3, lines 20-34 & Fig. 1).

Regarding **claim 15**, **Shih** discloses a print medium according to claim 14, wherein the index image areas form a regular grid (Col. 3, lines 20-34 & Fig. 1).

Regarding **claim 16**, **Shih** discloses a print medium according to claim 14 wherein the index image areas form a regular grid (Col. 3, lines 20-34 & Fig. 1).

Regarding **claim 17**, **Shih** discloses a method of storing data concerning a plurality of index images on a print medium including a substrate and a plurality of memory tags coupled thereto at locations spaced apart over the area of the substrate, wherein each memory tag has storage capacity to store a high resolution copy of an index image, the method comprising the steps of:

printing a plurality of index images onto the substrate wherein the plurality of index images are printed with low resolution (Col. 3, lines 20-34 & Fig. 1);

for at least one of the index images, storing data associated with the respective index image in the memory tag adjacent to it (Col. 3, lines 42-62 & Col. 5, lines 62-64);

printing a border onto the substrate, said border being printed proximate to a memory tag that is configured to store at least one of a list of index images, respective locations of the index images, and locations of the memory tags associated with at least one of the plurality of index images (Col. 8, lines 45-57 & Figs. 5-13).

Regarding **claim 18**, **Shih** discloses a method of storing data concerning a plurality of images comprising the steps of:

printing a plurality of visible index images onto a substrate, wherein the plurality of index images are printed with low resolution (Col. 3, lines 20-34 & Fig. 1);

applying a memory tag, comprising a passive electronic memory, to the substrate adjacent to at least one of the visible index images (Col. 5, line 58 - Col. 6, line 5 & Col. 8, lines 45-57);

applying a memory tag adjacent to a border, wherein the memory tag adjacent to the border is configured to store at least one of a list of index images, respective locations of the index images, and locations of the memory tags associated with at least one of the plurality of index images (Col. 8, lines 45-57 & Figs. 5-13);

for each visible index image adjacent to which a memory tag has been applied, storing data associated with the visible index image in the memory tag adjacent to it (Col. 3, lines 42-62, Col. 5, lines 62-64 & Col. 8, lines 45-57).

Regarding **claim 19**, **Shih** discloses a method according to claim 18 wherein the memory tags are applied to the substrate before the data is stored on them (Col. 3, lines 42-62 & Col. 5, lines 58-67 - *wherein the substrates are printed on with index images and the memory tag receives the information based on the information provided by the*

customer; therefore the memory tags are present in the substrate stock prior to receiving the film information).

Shih fails to teach or particularly point out:

a plurality of memory tags coupled to the substrate;
wherein each memory tag has storage capacity to store a high resolution copy of an image; and
wherein the memory tag associated with at least one of the plurality of index images is configured to store a high resolution copy of the index image it is associated with, as recited in **claim 1**;

a plurality of memory tags coupled thereto at locations spaced apart over the area of the substrate, wherein each memory tag has storage capacity to store a high resolution copy of an image;
wherein the memory tag associated with at least one of the index images is configured to store a high resolution copy of the index image it is associated with, as recited in **claim 12**;

a print medium according to claim 12, wherein a memory tag is located in each index image area, as recited in **claim 14**;

a print medium according to claim 14, wherein each memory tag is located in the same place with respect to the index image area in which it is located, as recited in **claim 15**;

a print medium according to claim 14 wherein the memory tags are located in different locations within the index image areas, as recited in **claim 16**;

each index image adjacent to a memory tag, and
said data including the respective index image at high resolution, as recited in **claim 17**;

each memory tag has storage capacity to store a high resolution copy of an image, and said data including the respective visible index image at high resolution, as recited in **claim 18**; and

a method according to claim 18 wherein the data is stored in the memory tags before they are applied to the substrate, as recited in **claim 20**.

Spurr teaches, regarding **claim 1**, a plurality of memory tags coupled to the substrate (Col .5, lines 5-9 & Col. 9, lines 18-22 – *wherein more than one tag may be used*);

wherein each memory tag has storage capacity to store a high resolution copy of an image (Col. 7, line 14 - Col. 8, line 22 & Col. 9, lines 15-22 - *wherein it is disclosed that various information can be stored on the memory tag and further disclosed that it would be known to further compress data or increase memory size for larger storage requirements; therefore capable of storing a high resolution image*); and

wherein the memory tag associated with at least one of the plurality of index images is configured to store a high resolution copy of the index image it is associated with (Col. 7, line 14 - Col. 8, line 22 & Col. 9, lines 15-22 - *wherein it is disclosed that various information can be stored on the memory tag and further disclosed that it would be*

known to further compress data or increase memory size for larger storage requirements; therefore capable of storing a high resolution image);

regarding **claim 12**, a print medium, comprising:

a plurality of memory tags coupled thereto at locations spaced apart over the area of the substrate (Col .5, lines 5-9 & Col. 9, lines 18-22 – *wherein more than one tag may be used in any configuration needed*),

wherein each memory tag has storage capacity to store a high resolution copy of an image (Col. 7, line 14 - Col. 8, line 22 & Col. 9, lines 15-22 - *wherein it is disclosed that various information can be stored on the memory tag and further disclosed that it would be known to further compress data or increase memory size for larger storage requirements; therefore capable of storing a high resolution image*);

wherein the memory tag associated with at least one of the index images is configured to store a high resolution copy of the index image it is associated with (Col. 7, line 14 - Col. 8, line 22 & Col. 9, lines 15-22 - *wherein it is disclosed that various information can be stored on the memory tag and further disclosed that it would be known to further compress data or increase memory size for larger storage requirements; therefore capable of storing a high resolution image*);

regarding **claim 14**, a print medium according to claim 12, wherein a memory tag is located in each index image area (Col .5, lines 5-9 & Col. 9, lines 18-22 – *wherein more than one tag may be used in any configuration needed*);

regarding **claim 15**, a print medium according to claim 14, wherein each memory tag is located in the same place with respect to the index image area in which it is

located (Col .5, lines 5-9 & Col. 9, lines 18-22 – *wherein more than one tag may be used in any configuration needed*);

regarding **claim 16**, a print medium according to claim 14 wherein the memory tags are located in different locations within the index image areas (Col .5, lines 5-9 & Col. 9, lines 18-22 – *wherein more than one tag may be used in any configuration needed*);

regarding **claim 17**, each index image adjacent to a memory tag (Col .5, lines 5-9 & Col. 9, lines 18-22 – *wherein more than one tag may be used in any configuration needed*), and said data including the respective index image at high resolution (Col. 7, line 14 - Col. 8, line 22 & Col. 9, lines 15-22 - *wherein it is disclosed that various information can be stored on the memory tag and further disclosed that it would be known to further compress data or increase memory size for larger storage requirements; therefore capable of storing a high resolution image*);

regarding **claim 18**, wherein each memory tag has storage capacity to store a high resolution copy of an image (Col. 7, line 14 - Col. 8, line 22 & Col. 9, lines 15-22 - *wherein it is disclosed that various information can be stored on the memory tag and further disclosed that it would be known to further compress data or increase memory size for larger storage requirements; therefore capable of storing a high resolution image*), and said data including the respective visible index image at high resolution (Col. 7, line 14 - Col. 8, line 22 & Col. 9, lines 15-22); and

regarding **claim 20**, a method according to claim 18 wherein the data is stored in the memory tags before they are applied to the substrate (Col. 6, lines 40-57 & Col. 9, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further employ the features of **Spurr** within the systems and methods of **Shih** for the benefit of increased reliability by allowing for access to the images even during times when the server or network may be out of service and for reducing costs associated with maintaining a server or database as well as fees associated with a service provider for internet access.

Response to Arguments

Applicant's arguments with respect to claims 1, 12, 17 and 18 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented **Shih et al. (US 6,674,923 B1)** in combination with **Spurr et al. (US 6,381,418 B1)** to reject the claims 1-20.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAULTEP SAVUSDIPHOL whose telephone number is (571)270-1301. The examiner can normally be reached on M-F, 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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